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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/604,563	06/27/2000	Elvin R. Lukenbach	JBP-506	5312

7590 05/31/2002

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EXAMINER
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BOYER, CHARLES I

ART UNIT	PAPER NUMBER
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1751

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DATE MAILED: 05/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/604,563

Applicant(s)  
Lukenbach et al

Examiner  
Charles Boyer

Art Unit  
1751



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jun 27, 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5 6) ☐ Other:

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## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 4 of copending Application No. 09/745270. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims contain essentially the same components.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### **Claim Objections**

3. The claims contain two claims numbered 23. For purposes of this action, they will be referred to as 23a and 23b.
4. Claim 24 is objected to because of the following informalities: "Pentaerythritol" is misspelled. Appropriate correction is required.

### **Claim Rejections - 35 USC § 112**

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 37 and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The dependency of claim 37 is incorrect. The claim should depend from claim 34. Claim 42 recites the limitation "benefit agent" in line 1. There is insufficient antecedent basis for this limitation in the claim.
7. Claims 51-54 provides for the use of personal care products and make-up removers, but, since the claim does not set forth any steps involved in the method/process, it is unclear what

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method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 51-54 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

### **Claim Rejections - 35 USC § 102**

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.  
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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Before citing the references against the present claims, the examiner would like to state for the record that due to the inordinate breadth of the present claims, requiring only a composition containing an ester, silicone, and solvent, the examiner estimates there are hundreds of reference that would anticipate at least claim 1 of the present application. Esters and silicones are extremely common components for use in detergent compositions, as well as other utilities such as cosmetics. The examiner has taken into consideration the present invention as a whole, in order to identify the closest prior art, which art is cited below. Applicants should be aware however, that there are many other references that could have been cited against the present invention. Any response from applicants to the references cited below that does not also address the fact that their claims are extremely broadly written, would likely not be successful in rendering those claims allowable.

9. Claims 1, 3, 5, 8-10, 17, 18, 23a, 25, 26, 30, 31, 33-35, 37, 38, and 54-56 are rejected under 35 U.S.C. 102(e) as being anticipated by Habif et al, US 5,989,572.

Habif et al teach compositions containing borage seed oil as an anti-irritant (see abstract). An example of such a composition is an oil in water emulsion comprising propylene glycol, hydroxyethyl cellulose, isopropyl palmitate, dimethicone, retinyl palmitate which is both an ester and a retinol derivative, sorbitan stearate, and water (col. 9, example 5). As this reference meets all material limitations of the claims at hand, the reference is anticipatory.

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Claims 1, 3, 8-10, 17, 18, 25, 26, 30, 31, 33-35, 37, 38, 47, and 54-56 are rejected under 35 U.S.C. 102(b) as being anticipated by Crotty et al, US 5,766,575

Crotty et al teach a method and composition for skin lightening (see abstract). An example of such a composition is a water in oil skin lotion comprising butylene glycol, glycerin, cetyl dimethicone, octyl octanoate, isononyl isononanoate, and water (col. 8, example 3). As this reference meets all material limitations of the claims at hand, the reference is anticipatory.

Claims 1, 3, 5, 8-10, 17, 18, 21, 22, 23a, 25, 30, 31, 34-37, 45, 46, and 54-56 are rejected under 35 U.S.C. 102(e) as being anticipated by Znaiden et al, US 5,814,662.

Znaiden et al teach skin treatment compositions (see abstract). An example of such a composition comprises propylene glycol, xanthan gum, peg-20 sorbitan isostearate, dimethicone copolyol phosphate, vitamin E linoleate, and water (col. 6, example 2). Another example contains cyclomethicone, ethyl alcohol, and isopropyl ppg-2 isodeceth-7-carboxylate (col. 7, example 5) and yet another example contains isostearyl palmitate, alkyl octanoate, glycerol hydroxystearate, xanthan gum, dimethicone, vitamin E acetate, vitamin A palmitate, and water (col. 7, example 6). As this reference meets all material limitations of the claims at hand, the reference is anticipatory.

Claims 1, 3, 5, 8-11, 23a, 23b, 25-31, 33-35, 37, 38, and 54-56 are rejected under 35 U.S.C. 102(e) as being anticipated by Jeffcoat et al, US 5,871,756.

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Jeffcoat et al teach skin and hair care compositions (see abstract). An example of such a composition is an aqueous based lotion comprising propylene glycol, Carbopol 941, octyl palmitate, alkyl benzoate, glyceryl stearate, dimethicone, copolyol, and water (col. 48, example 30). As this reference meets all material limitations of the claims at hand, the reference is anticipatory.

#### **Claim Rejections - 35 USC § 103**

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Znaiden et al, US 5,814,662.

Znaiden et al are relied upon as set forth above. Znaiden et al do not teach the specific mixtures of esters and dispersants presently claimed, nor do they teach each ultimate utility presently claimed. However, each of the presently claimed esters and dispersants are well known in the art for use in personal cleansing and cosmetic compositions. It would have been obvious to one of ordinary skill in the art to use well known esters and dispersants in the skin treatment compositions of Znaiden et al as esters and dispersants are taught as preferred components in their invention.



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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Boyer whose telephone number is (703) 308-2524. The examiner can normally be reached on Monday-Friday from 9:30 AM - 6:00 PM.

If reasonable attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta, can be reached on (703) 308-4708. The fax phone number for this Group is (703) 872-9310 for non-after-final amendments and (703) 872-9311 for after-final amendments.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Charles Boyer

A handwritten signature in cursive script that reads "Charles Boyer". The signature is written in black ink and is positioned to the right of the printed name "Charles Boyer".

May 28, 2002